

REMARKS

Claims 1-11 are pending. Independent claims 1 and 4 have been amended.

Entry of this amendment is requested as it clarifies the issues for appeal.

In paragraph 2 of the Office Action, claims 1-11 were rejected under 35 USC 103(a) as being unpatentable over U.S. Patent No. 6,418,419 (Nieboer).

Claim 1 relates to a method of facilitating trading, involving sending a trial order to a market, and receiving a report indicating that the trial order would have been paired if it had been a regular order, wherein a trial order is for discovery of current market depth at a price and is not an order to buy or sell.

Nieboer is directed to a conditional order routing and matching system wherein an order to buy or sell something is conditioned upon specified terms such as buying or selling something else, or the price of something else being a certain value (table bridging columns 9-10, examples 2 and 3). Nieboer's conditional order is executed when the conditions are met (column 15, lines 65-67).

Nieboer is not concerned with discovery of current market depth at a price, as specifically recited in claim 1, and further fails to show or suggest sending to a market a trial order that is not an order to buy or sell, as specifically recited in claim 1.

Thus, claim 1 is not anticipated by Nieboer. Claims 2-3, in depending from claim 1, incorporate all of its features and each of these claims is similarly patentably distinguishable from Nieboer.

As the Examiner admitted,

Niebor fail to explicitly teach wherein a trial order is for discovery of market depth at a price and is not an order to buy or sell shares.

However, the Examiner then stated that since Niebor teaches conditional orders, it would have been obvious

that Niebor teachings of conditional order when executed would have been able to perform inquiries of market debt [sic] at a price.

The claimed trial order is not an order to buy or sell, rather, the claimed trial order is a market data discovery tool. In contrast, Niebor's conditional order is an order that does not enable discovery of *current market* data. Only after Niebor's conditional order is executed, in some cases¹, does the order's owner find out what the market depth was when the order was executed, so at best, Niebor's conditional order, like any other market order, enables discovery of *previous market* data. It is prohibitively expensive to actually buy or sell just to find out what the market depth *was*, and even doing this does not reveal what the market depth *is*.

There is simply nothing in Niebor which renders the subject matter of claim 1 obvious.

Claim 4 relates to method of facilitating trading, comprising receiving a trial order, entering the trial order into an order file, and reporting when the trial order would have been paired had it been a regular order, wherein a trial order is for discovery of current market depth at a price and is not an order to buy or sell.

¹ Specifically, the execution report for a large market order reveals the price and quantity that was on the contra-side of the market if the book quantity at several prices was used to fill the market order. However, the purpose of a market order is to trade, not to discover market depth; the trading itself changes the market to a new unknown market depth.

Nieboer fails to show or suggest the trial order specifically recited in claim 4, and further fails to show or suggest the specific processing of the trial order recited in claim 4.

Thus, claim 4 is not anticipated by Nieboer. Claims 5-11, in depending from claim 4, incorporate all of its features and each of these claims is similarly patentably distinguishable from Nieboer.

Withdrawal of the rejection of claims 1-11 under 35 USC 103(a) is requested.

The Examiner is encouraged to call the undersigned to discuss any issues with this application. A Notice of Allowance is solicited.

Respectfully submitted,

Date: October 24, 2005

Brenda Pomerance

Brenda Pomerance
Reg. No. 36,894

Law Office of Brenda Pomerance
260 West 52 Street Ste. 27B
New York, NY 10019
voice 212 245-3940